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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,867	06/01/2001	Peter J. Malnekoff	MAL611SP0011US	2171

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EXAMINER

KEMPER, MELANIE A

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/871,867

Applicant(s)

MALNEKOFF, PETER J.

Examiner

M Kemper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 16 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15, 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal, patent number 6,239,867 in view of Newman et al., "A Multimedia Solution to Productivity Gridlock: A Re-Engineered Jewelry Appraisal System at Zale Corporation" MIS Quarterly, v. 18, n. 1, 3/1994.

Aggarwal teaches an input device for receiving gemstone data including cut type, weight, color, clarity, girdle thickness (see at least col. 3, lines 25-65, col. 4, lines 15-40, col. 14, lines 40-65); a processing device for computing a pricing estimate for use in a consumer evaluation report based upon the gemstone data (col. 16, lines 25-40, claims 25-26, 31); and an output device for communicating the report (col. 16, lines 35-40, col. 7, lines 5-10). Aggarwal does not clearly teach receiving predetermined gemstone data supplied by a user, however, a data file is accepted. It would have been obvious to one having ordinary skill in the art at the time of the invention to have inputted predetermined gemstone data in the automated evaluation system of Aggarwal since accepting predetermined data would have been adopted for the intended use of generating a data file of a gemstone or for the intended use of general query of the database for current market price information (col. 16, lines 25-40, claims 31, 34, 35). Aggarwal also teaches the report includes a summary description, a remote communication

section, a printer for printing the report, and a display for displaying the report (see at least col. 2, lines 40-60, col. 3, lines 10-15, col. 4, lines 45-55, col. 6, lines 50-60, col. 7, lines 30-40, col. 16, lines 25-45).

Newman teaches an input device adapted to receive gemstone data supplied by a system user of the type found on a gemstone grading certificate including cut type, weight, color, clarity, and cut proportions (Table 1, p. 24); a processing device adapted to compute a pricing estimate for use in an evaluation report based upon the data received (p. 24-26); an output device adapted to communicate the evaluation report to the system user (p. 25, 27). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the predetermined gemstone information as in Newman in the system and method of Aggarwal inputting provided information would have saved time over measuring each gemstone feature. It also would have been obvious to have implemented the processing device as in Newman since this would have been adopted for the intended use of generating the current market price information used for appraisals of Aggarwal. It also would have been obvious to have included a separate price estimate for each of a plurality of types of retail outlets since this would have been adopted for the intended use of providing the market price range provided in Aggarwal/Newman such as the retailer and "off price" retailer in Newman. It also would have been obvious to have the system user be a consumer in order to allow the user to determine updated appraisal information at least for resale value or insurance purposes.

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8,15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Newman et al, "A Multimedia...Zale Corporation", MIS Quarterly.

Newman teaches an input device adapted to receive gemstone data supplied by a system user of the type found on a gemstone grading certificate including cut type, weight, color, clarity, and cut proportions (Table 1, p. 24); a processing device adapted to compute a pricing estimate for use in an evaluation report based upon the data received (p. 24-26); an output device adapted to communicate the evaluation report to the system user (p. 25, 27). In the event that the claims can be interpreted differently, while the article describes inputting gemstone characteristics where the gemstone is present, the article also teaches that the information can be retrieved from an adoption sheet (p. 24). It would have been obvious to one having ordinary skill in the art at the time of the invention to have input the data from the adoption sheet for processing and determining the fair market value since this would have been adopted for the intended use of looking up the price for insurance purposes, for example. It also would have been obvious to input the information from the sheet since the system does not need

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the gemstone since the information is input by a user and not by a measurement device, or sensor.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al. as above.

Newman substantially shows the invention as described above, but does not specifically show including at least one of depth percentage, table percentage, girdle thickness, crown height...type of finish. However, it would have been obvious to have modified Newman to include at least girdle thickness since these additional values are well known in the art for determining and providing an evaluation report.

6. Claims 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Applicant's arguments filed on 7/30/03 have been fully considered but they are not persuasive. The applicant filed a 131 declaration in order to swear behind the Aggarwal reference. However, upon review of the provisional application, support exists for the claim limitations. Please see at least pages 6,9,14 and the figure showing the appraisal report. Also, the rejection is based upon the combination with Newman which also shows computing the fair market value. Thus, the declaration is not sufficient to overcome Aggarwal.

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8. The declaration filed on 7/30/03 under 37 CFR 1.131 has been considered but is ineffective to overcome the Aggarwal reference.

9. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the provisional reference.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "The Real Computer Payoff: part 3" provides a date of at least April 1995 for the Jewelry Judge.

Vig, patent number 5,911,131 teaches an automated appraisal with adjustment factors (fig. 1 and related text).

No Author, "British Online Valuation Service Now Available Here" Irish Times, 7/10/98 (whole document).

Vanier, 5828405 teaches an appraisal database (col. 6, lines 40-67).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



M Kemper  
Primary Examiner  
Art Unit 3622

MK  
November 17, 2003